

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jeffery N. Gleason

Serial No.: 10/690,319

Filed: October 20, 2003

For: INTERMEDIATE  
SEMICONDUCTOR DEVICE  
STRUCTURE (as amended)

Confirmation No.: 1135

Examiner: H. Trinh

Group Art Unit: 2814

Attorney Docket No.: 2269-5157.1US

VIA ELECTRONIC FILING  
October 23, 2007

SUPPLEMENTAL COMMUNICATION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In the Amendment filed October 16, 2007, Applicant included the following statement in response to the Examiner's obviousness rejection:

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be "a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness there must be a reasonable expectation of

success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

(October 22, 2007 Amendment, pages 5-6). While the case law is believed to accurately represent the standard for obviousness analysis, Applicant's presentation of the law appears to inadvertently attribute the above paragraph to M.P.E.P. §706.02(j). Applicant regrets any confusion the inclusion of the phrase "M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:" may have caused. The arguments and analysis contained in the response to the obviousness rejection in the Amendment of October 16, 2007, were properly based on the case law analysis cited therein and are appropriate despite the unintentional misquotation of M.P.E.P. §706.02(j). As set forth more fully in the Amendment of October 16, 2007, dependent claim 2 avoids Boleky at least for the same reasons as stated for allowable independent claim 1. Applicant refers to the October 16, 2007 Amendment for further arguments and remarks.

**CONCLUSION**

Claims 1-8 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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